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| 09/747,965 | 12/27/2000 | Mari Yajima | 1538.1007 (JDH) | 3205 |
| 21171 | 7590 | 06/21/2005 | EXAMINER | |
| STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005 | | | CHAMPAGNE, DONALD | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3622 | |

DATE MAILED: 06/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/747,965

Applicant(s)

YAJIMA ET AL.

Examiner

Donald L. Champagne

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 April 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Response to Arguments

1. Applicant's preliminary amendment filed on 1 April 2005 has been entered and is considered herein. The arguments filed after final on 2 March 2005 are also addressed herein at para. 8-11.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-31 and 33 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. "Client representation information" is new matter. The term "representation" is used only once in the disclosure, and that is with reference to the image of a tree (para. [0040] of the published application, US 20020007296A1).
4. The application does disclose images of members (clients, Fig. 1, where these images are called *votive panels 110 to 122* in para [0040]). If this is what applicant means by "client representation information", the rejection could be overcome by amending the phrase to more clearly indicate images of members/clients. Acceptable substitutes for "client representation information" include "client image information" and "pictorial representation(s)". See para. 11 below.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-31 and 33 are rejected under 35 U.S.C. 102(b) as being anticipated by Herz et al.
7. Herz et al. teaches (independent claims 1, 15, 22 and 30) a computer system, storage medium for storing a program, an information providing method and an information acquisition method, the information providing method comprising: receiving client (*user*) identification information from a terminal T_i-T_n of one client (col. 28 line 44 to col. 29 line 12); in response to said receipt of said client information, transmitting, to said terminal of said one client, display information (*hierarchical cluster tree*, col. 71 lines 4 and 27-31) specifying a *virtual community* (col. 72 line 63 to col. 73 line 36), which reads on representing information for said one client and client representation information for other clients who belong to a genre registered by said one client in advance are positioned at predetermined locations (at certain locations of the *cluster tree*, col. 24 lines 11-27).
8. Applicant argues (p. 4, bottom) that the *search profile* taught by Herz et al. is not "client representation information". In particular, applicant argues that Hertz et al. teaches a collection of attributes, not "representation of a client".
9. Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity, deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".
10. The instant application contains no such clear definition for the phrase "client representation information". Indeed, the examiner could not find this phrase in the disclosure. Hence, the examiner is required to give the phrase "client representation information" its broadest reasonable interpretation, which the examiner judges to be something that represents the client. The *search profile* taught by Herz et al. reads on this.

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11. In interpreting the phrase, the examiner considered the dictionary definition of "representation" (Merriam-Webster's Collegiate Dictionary) and performed a search of the US patent art for use of the term "representation" in the area of online information services.¹ The patent art search showed that "representation" was in common use in this art area to mean an image, but almost always with a modifier such as a "schematic", "graphical", "pictorial", or "3-D perspective" representation.
12. Herz et al. also teaches at the citations given above claims 2, 13 and 29; claim 3; claims 4, 16, 23 and 31, where the *search profile* (col. 4 lines 47-66) is the attribute registered in advance and the user selecting a subcluster reads on forming second display information for said second client; claims 11, 20 and 27, where "a predetermined time interval" is whenever the user decides to resubmit the *search profile* to update the *virtual community*; and claims 12, 21 and 28.
13. Herz et al. also teaches claim 5 (col. 6 lines 5-21); claims 6, 17 and 24, where *multicasting a new target object* (col. 38 lines 34-36 and 46-49) reads on "registering a comment"; claims 7-10, 18-19 and 25-26 (col. 12 lines 30-31); and claim 14, where *user's interests* (col. 17 line 16) reads on "dream".
14. Claim 32 is rejected under 35 U.S.C. 102(b) as being anticipated by Okura (US005829003A). Okura teaches a computer system for generating organization charts, comprising a unit (*program storage unit 60*, col. 5 line 50) that receives client identification information (*information about employees belonging to a company*, col. 1 lines 9-10) from a terminal of one client (*input unit 20*, col. 1 line 55); and a unit that transmits (*the remote equipment on which program storage unit 60 is located*, col. 5 lines 61-65) to said terminal of said one client (*display device 30*, col. 6 line 6) display information in which an image to identify said one client (i.e., the employee acting as the *operator*, col. 2 line 18) and images to identify other clients (other employees) who belong to a genre (company employees) registered by said one client (entered into the system by said *operator*) in advance are positioned at predetermined locations, in response to a receipt of said client identification information (Fig. 4 and col. 5 lines 25-28, col. 20 lines 31-36 and col. 28 lines 40-47).

¹ The search, entitled "representation_art_use", was performed on 13 June 2005 and has been made of record.

Conclusion

15. The references made of record and not relied upon are considered pertinent to applicant's disclosure. Glaser (US006072463A) teaches some aspects of the instant invention (e.g., para. 0007).
16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donald L Champagne whose telephone number is 571-272-6717. The examiner can normally be reached from 6:30 AM to 5 PM ET, Monday to Thursday. The examiner can also be contacted by e-mail at donald.champagne@uspto.gov, and *informal* fax communications (i.e., communications not to be made of record) may be sent directly to the examiner at 571-273-6717.
17. The examiner's supervisor, Eric Stamber can be reached on 571-272-6724. The fax phone number for the organization where this application is assigned is 703-872-9306.
18. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).
19. **ABANDONMENT** – If examiner cannot by telephone verify applicant's intent to continue prosecution, the application is subject to abandonment six months after mailing of the last Office action. The agent, attorney or applicant point of contact is responsible for assuring that the Office has their telephone number. Agents and attorneys may verify their registration information including telephone number at the Office's web site, www.uspto.gov. At the top of the home page, click on Site Index. Then click on Agent & Attorney Roster in the alphabetic list, and search for your registration by your name or number.

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

Donald L. Champagne
Primary Examiner
Art Unit 3622

15 June 2005